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In re Application of
VILLERS
Serial No.: 10/531,217
PCT No.: PCT/FR03/03012
Int. Filing Date: 13 October 2003
Priority Date: 16 October 2002
Atty Docket No.: 11345/120001
For: DISPLAY SCREEN CAPABLE OF BEING
SUBJECTED TO A SCROLL PROCEDURE

DECISION ON PETITION

UNDER 37 CFR 1.47(b)

This decision is in response to the "Petition Under 37 CFR § 1.47(b)" filed 06 March 2006 in the United States Patent and Trademark Office (USPTO). Applicant has authorized the charging of the \$200.00 petition fee to deposit account number 50-0591.

BACKGROUND

On 13 October 2003, applicant filed international application PCT/FR03/03012, which claimed a priority date of 16 October 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 29 April 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 16 April 2004.

On 14 April 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee, an English translation of the international application, an Information Disclosure Statement, an Application Data Sheet and a preliminary amendment.

On 05 August 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of \$130.00 for filing the oath or declaration later than 30 months from the earliest priority date. (37 CFR 1.492(e)). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 06 March 2006, applicant responded with the present petition accompanied by a petition for a five-month extension of time. With the payment of the five-month extension of time fee and the fact that 05 March 2006 was a Sunday, applicant's present filing is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1), (3) and (5).

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." Applicant has presently provided a declaration from Ms. Isabelle Thibaudeau to support the showing that inventor Villars was supplied with a complete set of the application papers but refuses to execute the declaration. However, there are some questions which remain before this element can be satisfied. The papers mailed on 28 February 2006, which per the Thibaudeau declaration included a copy of the application appears to have been mailed to a different address than the "last known address" as listed on the petition. Specifically, "11 allée Concorde, 95000 CERGY" versus "16 Passage des Ballades, 95800 Cergy Pontoise." This calls into question what the last known address of the inventor is and whether he in fact received a complete set of application papers. It is especially important to show that the applicant has been presented with a complete set of the application papers in instances such as this where the silence or non-action of the inventor is the basis of refusal to sign.

In addition, the 02 March 2006 email from Mr. Durand indicates that he has gotten the inventor's signature. It appears from Mr. Dersoir's email of 06 March 2006 that notwithstanding the 02 March 2006 email, the documents supplied did not include a declaration signed by inventor Villars. A renewed petition should confirm this and include any subsequent response from Mr. Durand or the inventor.

Regarding item (4), applicant has not filed a compliant declaration executed by the corporate entity on behalf of the non-signing inventor. As explained in the Manual of Patent Examining Procedure at § 409.03(b):

Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on

behalf of a corporation under 37 CFR 1.47(b).

(B) The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.

Regarding item (6), applicant has not provided a statement that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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